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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,491	01/09/2002	Hidehei Kageyama	No. 50	2851

7590 07/15/2003

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EXAMINER

PRUNNER, KATHLEEN J

ART UNIT	PAPER NUMBER
3751	7

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/040,491	KAGEYAMA ET AL.
	Examiner Kathleen J. Prunner	Art Unit 3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 April 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,4-8,10,13-17 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1, 4-8, 10, 13-17 and 19-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 January 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____                                    |

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**DETAILED ACTION*****Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings **must show** every feature of the invention specified in the claims. Therefore, the “operating part for causing said lead (writing medium) feeding mechanism to feed the lead (writing medium)”, as called for by claims 1 and 10, must be shown or the feature(s) canceled from the claims. No new matter should be introduced or it will not be entered. **A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application.** The objection to the drawings will not be held in abeyance.
2. Applicant is required to submit a proposed drawing correction **in reply to this Office action** in order to avoid abandonment of the application. Any proposal by the applicant for amendment of the drawing to cure defects **MUST** be embodied **in a SEPARATE LETTER to the Draftsman.** See MPEP §608.02(r). The objection to the drawings will not be held in abeyance.

***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The claimed subject matter which lacks such antecedent basis is as follows: (A) “a contact portion”, as called for by claim 1; (B) “<sup>drop if #8 entered</sup> a contact portion for contacting an inner peripheral face of the barrel”, as called for by claims 1 and 10; (C) “a (said) (the) writing medium holder”, as called for by claims 10 and 21; (D) “a through hole through which a writing medium penetrates”, as called for by claims 10 and 21; (E) “a (the) writing medium”, as called for by claims 10 and 21; (F) “holding portions formed on said writing medium holder”, as called for by claim 21; (G) “holding portions being formed at two or more

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positions along an axial length of said writing medium holder", as called for by claim 21; and  
*drop if # 8 entered*  
(H) "writing medium feeding mechanism", as called for by claim 10. Correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- # 8 entered*  
5. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 20 is indefinite since it is unclear as to how "a consumed writing medium", i.e., a writing medium that has been completely used up or done away with completely, can be "held by the blade".

***Claim Rejections - 35 USC § 102***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1, 4-8, 10, 13-17, 19-21 are rejected under 35 U.S.C. 102(a) as being anticipated by Kanari et al. Kanari et al. disclose a mechanical pencil having all the claimed features including a barrel (constituted by main body 20 and mouthpiece 32), a lead feeding mechanism (note lines 44-48 in col. 3) disposed in the barrel to tighten and feed a lead 22, a lead holder (constituted by lead-holding member 36 and slider 44, note Fig. 3) disposed between the lead feeding mechanism and a tip end of the barrel (note Fig. 1), the lead holder having a through hole 40 through which the lead 22 passes (note Fig. 2) and having holding portions 52 for holding the lead 22 and a contact portion for contacting an inner peripheral face of the barrel (note Fig. 1), the holding portions 52 including

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a first holding portion 52 at a front portion of the lead holder and a second holding portion 52 at a rear portion of the lead holder (note Fig. 3) so that when a length of the lead 22a becomes shorter than a distance between the lead feeding mechanism and the tip end of the barrel, the first holding portion 52 holds the short lead 22a and the second holding portion 52 holds a next lead 22b (note lines 5-9 in col. 1 and Figs. 4 and 5) tightened by the lead feeding mechanism (note lines 13-22 in col. 7) especially when the lead 22a is so short so as to not completely occupy the lead holder and the next lead 22b is to be smoothly advanced to continue the writing operation. With regard to claims 4 and 13, Kanari et al. further discloses that the lead holder has a body 36 (note Fig. 3) and an outside cylinder 50 provided concentrically on an outside of the body and being formed with a rib 44 (note Fig. 3) projecting in an outside diameter direction to come into contact with an inner peripheral face of the barrel 20, 32. With regard to claims 5 and 14, Kanari et al. additionally disclose that the outside cylinder 50 has a slit 78 (note Fig. 8A) formed in a portion of the outside cylinder in which the rib 44 of the outside cylinder is absent. With respect to claims 6 and 15, Kanari et al. also disclose that the lead holder has a body being formed of at least one blade 74 (note Fig. 8A and lines 58-62 in col. 4) projecting in an inside diameter direction in a front end part of the body to come into contact with the lead 22. With respect to claims 7 and 16, Kanari et al. further disclose that the lead holder has a body being formed with a rib constituted by each lead holding portion 52 (note Fig. 3) projecting in an inside diameter direction in a rear end part of the body to come into contact with the lead 22. With regard to claims 8 and 17, Kanari et al. additionally disclose a slit 78 (note Fig. 8A) formed in a portion in which the rib is absent at the rear end part of the body. With respect to claim 19, Kanari et al. additionally disclose that the holding portions can constitute a blade 74 and a rib 52 in the case when the lead holder is formed integrally with the slider/outside cylinder 50,44 (note Figs. 3 and 8A, and lines 58-62 in col. 4). With respect to claim 20, Kanari et al. also disclose that one of the lead holding portions is forwardly positioned and

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another one of the lead holding portions is rearwardly positioned (note Fig. 3). With respect to claim 21, Kanari et al. also disclose a tip end of the barrel (note Fig. 2), a writing medium holder (constituted by lead-holding member 36 and slider 44, note Fig. 3) held by the tip end of the barrel and having a through hole 40 through which a writing medium 22 protrudes, and holding portions for holding the writing medium 22, the holding portions 52 being formed at two (note Fig. 3) or more (note lines 53-55 in col. 4) positions along an axial length of the writing medium holder, the holding portions including a first holding portion 52 at a front portion of the holder and a second holding portion 52 at a rear portion of the holder (note Fig. 3), wherein when a length of the writing medium 22a becomes short, the first holding portion 52 holds the short writing medium 22a and the second holding portion 52 holds a next unused writing medium 22b (note lines 5-9 in col. 1 and Figs. 4 and 5) especially when the writing medium 22a is so short so as to not completely occupy the lead holder and the next writing medium 22b is to be smoothly advanced to continue the writing operation.

*Response to Arguments*

9. Applicants' arguments filed April 15, 2003 (Paper No. 6) have been fully considered but they are not deemed persuasive.

10. Contrary to applicants' assertions, the two lead-holding portions 52 of the Kanari et al. reference are indeed essential for the reference to contact and frictionally hold the lead since that is the minimum number of holding portions that this reference discloses when a plurality of holding portions are used.

11. Applicants' arguments with regard to the Kanari et al. reference have been carefully considered. However, although the Kanari et al. reference does not specifically have a figure showing that the holder holds both leads, it is considered that the reference clearly suggests, as noted

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in the above rejection of the claims, that the holder would indeed hold both leads (short lead 22a and next lead 22b) when the protruding lead (short lead 22a) is so short so as to not completely occupy the holder. Such would be the case in order for the mechanical pencil to function properly and smoothly advance lead when needed to continue a writing operation.

*Conclusion*

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. The Examiner is advising attorneys to FAX any response due to Office actions. The U. S. Patent and Trademark Office (USPTO) is experiencing major delays in matching up papers that were mailed. Due to the Anthrax issue, any mail sent to the USPTO is automatically sent to an irradiation center in Virginia. It has been found that the irradiation process makes papers too brittle to handle. Therefore, the irradiation center has to further copy each paper. The originally filed irradiated papers are then placed in a sealed envelope and put in the associated file. After this irradiation process, the "papers" are then sent to the Office where they are matched with the file. This entire procedure causes months in delays due to the quantity of mailed received. Therefore, it is suggested that any

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response be sent by FAX especially if a time limit is critical. The FAX number for the technical center where this file is located is given in the paragraph below.

14. Any inquiry concerning this communication from the examiner should be directed to Examiner Kathleen J. Prunner whose telephone number is 703-306-9044. The examiner can usually be reached Monday through Friday from 5:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson, can be reached on 703-308-2580. The FAX phone number for the organization where this application is assigned is 703-308-7766.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-0861.



Kathleen J. Prunner:kjp

July 11, 2003



GREGORY L. HUSON  
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